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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/299,388	04/27/1999	RICHARD FOTLAND	99.01	3198

7590

05/06/2003

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EXAMINER

CHOI, FRANK I

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 05/06/2003

*28*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/299,388

Applicant(s)

FOTLAND ET AL.

Examiner

Frank I Choi

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 16 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: \_\_\_\_\_
3. ☒ Applicant's reply has overcome the following rejection(s): 112 - 2<sup>nd</sup> paragraph rejection, rejection over WO 98/42446
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600



Continuation of 5. does NOT place the application in condition for allowance because: With respect to the 112-1st paragraph rejection of claims 1 and 48, Applicant argues that language specifying that the particles have essentially a zero velocity and that the aerosol is essentially stationary are within the spirit and scope of Applicant's invention. However, Applicant did not reference any specific disclosure which would lead one of ordinary skill in the art to conclude that the amended claim language was within the spirit and scope of the Applicant's invention. Applicant makes the following statement "it is clear that the particles have no velocity prior to application of the electrical field. Otherwise, there would be no reason for applying an alternating electric field as required by Applicants' invention!". However, in the Specification, the aerosol is moved by an air or nitrogen gas stream (Pg. 17, lines 17-20, Pg. 18, lines 20,21, Pg. 19, lines 1-7). As such, although removal of the particles from the aerosol and deposition on to the dielectric substrate is done by applying an alternating electric field, the Specification indicates that the aerosol is flowing through the various regions by action of an air or nitrogen gas stream. Therefore, the aerosol is not stationary and consequently it does not appear that one of ordinary skill in the art would conclude that the particles have essentially zero velocity. Examiner notes that even if Applicant provides specific support from which one of ordinary skill in the art could conclude that the above amended claim language or other claim language is within the spirit and scope of the Applicant's invention, Applicant is reminded that where any claim which contains subject matter not originally claimed or embraced in the statement of the invention, a supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP § § 602.01 and 602.02. Also for purposes of providing antecedent basis the summary of the invention should be amended to insert said claim language. See MPEP § § 608.01(o) and 1302.01..



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